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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/392,676    09/08/99    SAINTON    J    0357-20

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WM41/0717

EXAMINER

URBAN, F

ART UNIT

PAPER NUMBER

2683

DATE MAILED:

07/17/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/392,676**

Applicant(s)

**Sainton et al.**

Examiner

**Edward F. Urban**

Art Unit

**2683**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on May 29, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-46 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☒ Claim(s) 1-41 is/are allowed.

6) ☒ Claim(s) 42-46 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: \_\_\_\_\_

Art Unit: 2683

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2683

3. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker in view of Andrews and Barber et al.

Zicker discloses a wireless communication system containing a plurality of independent wireless service networks 14,16 for providing wireless services within a common geographic region, a plurality of portable radio devices 12 for allowing access to the wireless service networks 14,16, each containing an accessing circuit 66 for providing access to any one of the plurality of wireless service networks by requesting and establishing access, memory 70,72 for storing a "user criteria" for selecting a wireless service (figure 14) and a control signal generator (also within 66) for automatically generating the access control signal in response to an automatic selection of the wireless network that best satisfies the stored criteria for wireless service and for causing the accessing circuit to access the wireless service network. Zicker does not specifically disclose the portable radio devices are frequency and protocol agile. However, such a technique is shown by Andrews which disclose a portable radio device 10 having the capability to adjust the radio frequency and protocol in response to a control signal when changing to a different system. Therefore, it would have been obvious to one having ordinary skill in the art to apply this frequency and protocol agile portable radio of Andrews to the system of Zicker for the purpose of allowing the portable radio to access more a higher variety of systems. Also not specifically disclosed is the feature of "memory for storing a user criteria for selecting a wireless service" at the portable radio device. However, such a technique is common as shown by Barber et al. in which a user selected criteria stored within the radio device is used in determining which service

Art Unit: 2683

to select from (col. 2, line 50 - col. 3, line 3). Therefore, it would have been obvious to one having ordinary skill in the art to apply this user criteria selection technique of Barber et al. to the modified system of Zicker and Andrews for the simple purpose of allowing the user to obtain more control in determining which system should be selected.

### *Reissue Applications*

4. Claims 42-46 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

A question of patentability is raised with respect to claims 42-46 under 35 U.S.C. 251 based upon lack of error. Specifically, the asserted reissue claims are broader than the original claims withing the meaning of "recapture rule" (see MPEP 1412.02; *In re Clement*, 45 USPQ 2d 1161 (Fed. Cir. 1997)), which prohibits grants of reissue claims that are broader than original claims in a manner directly pertinent to the subject matter surrendered during prosecution.

Specific attention is directed to new independent claims 42-46. During prosecution of the parent patent, applicant's representative, in paper no. 8 (received May 22, 1995), included the

Art Unit: 2683

following limitations in order to distinguish the claimed invention from the prior art: “a plurality of wireless communication networks using differing radio frequency modulation protocols and differing radio frequencies”, “a first wireless communication network operating using a first radio frequency spectrum allocated to said first wireless communication network and using a first modulation protocol” and “a second wireless communication network operating using a second radio frequency spectrum allocated to said second wireless communication network and different from said first radio frequency spectrum and using a second modulation protocol”.

As set forth in *In re Clement*, 45 USPQ 2d 1161 (Fed. Cir. 1997), if the reissue claim is as broader than the canceled or amended claim in all aspects, the recapture rule bars the claim, which prohibits grant of reissue claims that are broader than the original claims in a manner directly pertinent to subject matter amended during prosecution.

Applicant's claims 42-46 are broader than the original patent claim 1 in exactly the area amended for patentability in the parent prosecution.

Although the recapture rule may be avoided in some circumstances, such as where claims that are broader in certain respects were materially narrowed in other respects, independent claims 42-46 do not appear to be materially narrowed to avoid recapture.

Applicant argues that the newly added claims 42-46 in the reissue application does not amend the patented claimed invention, but instead presents claims to other embodiments of the disclosed radio frequency management system which are different from those of patented claims 1-22 and is more directed to claim 23. However, it is still considered that reissue claims 42-46

Art Unit: 2683

are directed more so toward claims 1 and 13 in that they both commonly deal with a radio frequency management system which reallocates radio spectrum among a plurality of wireless communication networks having different frequencies and protocols through the use of control signal generation. Therefore, since claims 42-46 are considered to be more directed to claims 1 and 13 than they are to claim 23, then the application of the recapture rule still applies.

5. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

6. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Allowable Subject Matter***

7. Claims 1-41 are allowed.

Art Unit: 2683

*Response to Arguments*

8. Applicant's arguments with respect to claims 25-46 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Urban whose telephone number is (703) 305-4385.

EFU

July 13, 2001

  
EDWARD F. URBAN  
PRIMARY EXAMINER